

REMARKS

Claims 1-29 are pending in this application. Claims 1-29 stand finally rejected. By this Amendment, claim 2 is canceled. Claims 1 and 3-5 are amended. Claim 11 is amended to overcome a rejection under 35 U.S.C. 112(2). Claim 30 is added.

In view of the foregoing amendment and the following remarks, reconsideration is respectfully requested. Applicant responds to the numbered paragraphs of the Office Action in turn.

In Paragraph 1 of the Office Action, the examiner responds to Applicant's previous arguments only with respect to claim 1. The examiner states that the claimed limitation in claim 1 of "one of said selected music recordings" is broadly claimed in claim 1" and that the "claim does not clearly specify what the music recording is (is it the whole of the song, part of the song, or just a short portion of it?)." The examiner then concludes that, "[t]herefore, the preceding limitation is read by the teaching in Walsh et al. (see column 17, lines 16-18)."

Applicant respectfully traverses the position of the examiner. As the examiner states, claim 1 broadly claims a "music recording". Whether the music recording contains a whole, a part, or a short portion of a song is not relevant. Indeed, the claimed "music recording" that is retrieved "for complete storage . . . in said memory" may be any of a whole, a part, or a short portion of a song. Additionally, nothing in Walsh et al., including the cited column 17, lines 16-18, teaches or suggests downloading a music recording to a wireless communications device for storage in a memory of the device. The cited text of Walsh et al. teaches only that the microprocessor 122 of the device in Walsh et al. includes memory for storing "programs and data, and a protected memory 128 for storing program information essential to the operation of the system methods of the invention." Although Walsh et al. teach transmission of an informational message (which may include music) to a wireless communications device, nothing in Walsh et al. teaches or suggests storing such a message (and in particular a music recording) in a memory of the wireless communications device. Indeed, Walsh et al. teach away from applicant's claims given their detailed teachings only of multimedia informational messages (which may include music) being transmitted in real-time to (but not stored in) a wireless communications device.

In paragraph 3 of the Office Action (after quoting a portion of 35 U.S.C. 112, second paragraph in Paragraph 2), the examiner rejects claims 11 and 12 based upon Section 112, second paragraph. In particular, the examiner correctly notes that claim 11 recites the limitation "said encoded music" and that there is insufficient antecedent basis for this limitation in the claim. Applicant has amended claim 11, which depends from claim 1, to correct this deficiency by deleted "encoded music" and substituting therefore "retrieved music recording" (which has antecedent basis in claim 1). Accordingly, it is believed that the rejection of claim 11 is overcome.

The examiner also rejects claim 12 and contends that there is insufficient antecedent basis for the limitation "said music recording". However, claim 12 depends from claim 7. Claim 7, as previously amended, recites "a music recording" in line 3. Accordingly, it is believed that the rejection of claim 12 based upon Section 112(2) should be withdrawn.

Claim 1 has been amended for clarity by incorporating the limitations originally found in claim 3 of "portable" and "handheld". Claim 2 is canceled. It is apparent that the claimed wireless communications device can be a voice communications device. Claim 3 is amended to depend from claim 1 (rather than canceled claim 2) and to delete the subject matter that has been rolled up into claim 1. Claims 4-5 are each amended to depend from claim 1 (rather than canceled claim 2). No new subject matter is added by these amendments. Further, the amendment does not necessitate a new search since the subject matter of claim 1, as amended, was already present in claim 3. Additionally, applicant notes that this amendment to claim 1 was not made in specific response to a rejection.

In paragraph 5 of the Office Action (after reciting portions of 35 U.S.C. 102 in paragraph 4 of the Office Action), the examiner rejects claims 1-3, 5-6, 17, 24 and 26-29 under 35 U.S.C. 102(e) as being anticipated by Walsh et al. (U.S. Patent No. 6,144,848). Applicant traverses these rejections and requests reconsideration.

Concerning claim 1, nothing in Walsh et al. teaches or suggests completely storing a music recording, wirelessly retrieved from a remote storage facility or server, in a memory of a wireless communications device. Rather, in Walsh et al., multimedia information messages sent to a wireless device are not stored in memory for playback.. Accordingly, applicant believes that the rejection of claim 1 should be withdrawn.

Concerning claim 17, Walsh et al. do not teach or suggest at least a cellular telephone or handheld computing device with a "memory having a music recording stored therein", as claimed. Accordingly, applicant believes that the rejection of claim 17 should be withdrawn.

Concerning claim 29, Walsh et al. does not teach or suggest at least a cellular telephone or handheld music device with "a memory capable of storing a music recording in an encoded format" and a "decoder capable of decoding the encoded format". Accordingly, applicant believes that the rejection of claim 29 should be withdrawn.

In rejecting these claims, the examiner cites column 3, lines 40-59 and Figure 1A of Walsh et al. However, the cited text and Figure 1A of Walsh et al. do not support the rejection.

Regarding dependent claims 2, 3, 5, 6, 24, and 26-28, applicant believes that each of these claims is allowable by virtue of its dependence from an allowable base claim and also by virtue of the additional limitation(s) set forth in each dependent claim. Applicant notes specifically that nothing in Walsh et al. teaches or suggests a "third generation network" (claim 6).

Also, with specific reference to claim 28, Walsh et al. does not teach or suggest downloading a music recording "from an account associated with said device or a user of said device." Claim 28 is directed to a feature of Applicant's invention that enables a user to store his or her music recordings in an online storage account associated with the user or his or her communications device. Citing column 10, line 14 of Walsh et al., the examiner rejects claim 28. However, column 10, line 14 of Walsh et al. deals with invoicing a customer for a payment and "charging payment against an account or credit card." Walsh et al. has absolutely no teaching or suggestion of a user storage-account from which music may be downloaded, as claimed in claim 28.

In paragraph 7 of the Office Action (after recited portions of 35 U.S.C. 103 in paragraph 6), the examiner rejects claim 4 under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. Claim 4 includes a limitation that "the wireless communications device is installed in a vehicle." Applicant traverses the examiner's rejection because Walsh et al. teach a device having a bar code reader for scanning bar codes and sending bar coded command messages to a remote server. The examiner has not shown how Walsh et al. could be properly used in that fashion if it is installed in a vehicle, as claimed.

In paragraph 8 of the Office Action, the examiner rejects claims 7-10 and 25 under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. (U.S. Patent No. 6,144,848) in view of Donner (U.S. Patent No. 5,722,069). Neither Walsh et al. nor Donner teach or suggest storing a music recording or encoded music in a memory of a wireless communications device (such as a cellular telephone) or a PDA. Accordingly, their combination (which applicant does not concede is a proper combination) does not result in the claimed invention.

With respect to claims 9-10 and 25 specifically, the examiner concedes that even the combination of Walsh et al. and Donner does not teach a removable memory. Nevertheless, the examiner contends that a removable memory is "well known and commonly used in the art." The examiner provides no support for this conclusion. As such, this rejection is improper and should be withdrawn. Additionally, in response to the examiner's position, applicant submits that there is no known prior art teaching or suggestion of a "removable memory" in a "wireless communications device", a "cellular telephone" or a "handheld computing device" for storing a music recording or encoded music. The removable memory of applicant's claimed invention is significant for at least its ability to provide portability of the music storage medium and the ability to provide additional storage capacity to the device without burdening the device itself with the cost of such memory. This aspect of Applicant's invention also allows the user to select the size of memory desired or needed. In short, applicant believes that the examiner's rejection of claims 9-10 and 25 is unsupported and should be withdrawn.

In paragraph 9 of the Office Action, the examiner rejects claims 11-13, 18-20, and 22-23 under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. (U.S. Patent No. 6,144,848) in view of Steele et al. (U.S. 2002/0046084). Applicant traverses these rejections. Applicant submits that Walsh et al. and Steele et al. cannot be properly combined and, even if combined,

they do not teach or suggest applicant's claimed invention(s). In particular, each of the claims rejected in this paragraph are dependent and are believed to be allowable by virtue of their dependence from allowable base claims (for at least the reasons set forth above) and also by virtue of the additional limitation(s) set forth in each claim.

With specific reference to claim 23, the examiner rejects claim 23 on the grounds that Steele et al. teaches a music recording encoded in mp3 format. However, claim 23 is directed a device "further comprising an input for selecting a one of said music recordings for playback." Accordingly, the rejection is improper.

In paragraph 10 of the Office Action, the examiner rejects claims 14-16 and 21 under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. (U.S. Patent No. 6,144,848) in view of Buchheim (U.S. Patent No. 6,061,306). . Applicant traverses these rejections. Applicant submits that Walsh et al. and Buchheim cannot be properly combined and, even if combined, they do not teach or suggest applicant's claimed invention(s). In particular, each of the claims rejected in this paragraph are dependent and are believed to be allowable by virtue of their dependence from allowable base claims (for at least the reasons set forth above) and also by virtue of the additional limitation(s) set forth in each claim.

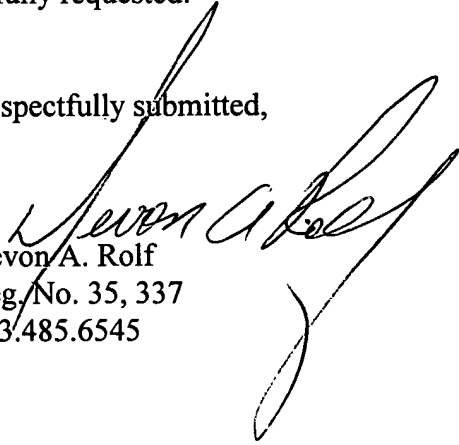
Applicant does not concede that any of the references relied upon by the examiner in support of a rejection under Section 103 are analogous and reserves the right to submit supplemental arguments on this issue. Further, Applicant does not concede that Steele et al. And Buchheim are prior art and reserves the right to submit supplemental arguments and/or information on this issue.

Applicant has added new claim 30. Claim 30 depends from claim 1 and includes the limitation that said at least on music recording stored in said memory "can be played without the need to establish and maintain a communications link with said remote storage facility." This claim further distinguishes the present invention from the teachings of Walsh et al, noting the examiner's comment that this particular limitation (argued previously by the applicant for the purpose of illustrating a difference between Walsh et al.'s teachings and applicant's invention) "is not found in claim 1." Applicant believes that claim 30 is allowable.

Applicant requests entry of claim 30. Entry of claim 30 adds no new subject matter into the application and should require no new search. Although a claim is added, a claim has been canceled. This claim was not introduced earlier because (a) applicant believed (and continues to believe) that it is not a necessary limitation to achieve allowable subject matter (although applicant does believe that the subject matter of claim 30 is additionally allowable subject matter) and (b) Applicant is requesting entry of the claim as the result of the Examiner's comment in the latest Office Action that this particular limitation is not in the claims.

In view of the foregoing amendments and remarks, it is believed that this application is in condition for allowance. Such action is respectfully requested.

Respectfully submitted,


Devon A. Rolf
Reg. No. 35, 337
913.485.6545